

REMARKS

Claims 1-21 are in the case and are presented for reconsideration. Claim 4 has been amended. No new matter has been added.

Claims 4-8 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The amendment made to Claim 4 is believed to have overcome this objection.

Claims 1-5 and 9-5 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5, 755,715 (Stern et al.) in view of U.S. Patent No. 6,334,093 (More). Claims 6-8 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5, 755,715 (Stern et al.) in view of U.S. Patent No. 6,334,093 (More) and further in view of U.S. Patent No. 6,569,160 (Goldin et al.). Claims 16-21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5, 755,715 (Stern et al.) in view of U.S. Patent No. 6,334,093 (More) and further in view of U.S. Patent No. 6,563,418 (Douglas et al.).

Focusing on the cited prior art references, Stern et al. describes tissue heating and ablation systems and methods using time-variable set point temperature curves for monitoring and control. Contrary to Examiner's interpretation of the teachings in this reference, Stern et al. merely teaches a using a temperature sensing element that is actually a small bead thermistor located at the tip of its ablation electrode. Col. 4, Lines 28-36.

It is important to note that the thermistor taught in Stern et al. is not in any way used as a position sensor for providing signals used in determining position and/or orientation coordinates (of a medical device) nor are the system and method taught in Stern et al. use any type of location system, particularly a location system capable of determining position and/or orientation coordinates of a position sensor located on a medical device wherein the temperature at the position sensor is determined by providing a temperature signal to the position sensor and measuring voltage at the position sensor and determining a resistance value based on the temperature measurement signal and the voltage such as uniquely claimed by Applicant's claimed present invention.

More merely teaches a method and apparatus for economical drift compensation in high resolution difference measurements and exemplary low cost, high resolution differential digital thermometer. Although this reference does address a drift compensation technique, there is absolutely no teaching, suggestion or even inference that this technique could be combined with a system and method that uses a location system capable of determining position and/or orientation coordinates of a position sensor located on a medical device wherein the temperature at the position sensor is determined by providing a temperature signal to the position sensor and measuring voltage at the position sensor and determining a resistance value based on the temperature measurement signal and the voltage such as distinctly claimed by Applicant's claimed present invention.

Additionally, as set forth in 35 USC § 103 (c) (1):

Subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

It is important to note that the prior art rejection of Claims 6-8 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5, 755,715 (Stern et al.) in view of U.S. Patent No. 6,334,093 (More) and further in view of U.S. Patent No. 6,569,160 (Goldin et al.) outlined above, is not only based on 35 USC § 103, but also would also have to be considered to constitute prior art against Applicant's claimed present invention under 35 USC § 102 (e).

It is also important to note that both U.S. Patent No. 6,569,160 (Goldin et al.) and Applicant's instant application are owned by the same person, i.e. Biosense Webster, Inc. as the assignee. Thus, under 35 USC § 103 (c) (1), Applicant's U.S. Patent No. 6,569,160 (Goldin et al.) is clearly exempt from being applied as a prior art reference against Applicant's instant application. Accordingly, Applicant respectfully requests that Applicant's U.S. Patent No. 6,569,160 (Goldin et al.) be removed from consideration and this rejection be withdrawn.

Serial No. 09/882,126

Even if Goldin et al. were considered to be a proper prior art reference, it is important to note that Goldin et al. merely teaches a system and method for detecting electrode-tissue contact. Although Goldin et al. discloses use of a position sensor (location sensor 28), there is no teaching or suggestion in this reference that the location sensor 28 could ever be used in a method for measuring temperature at a site within a patient such as found with the novel method steps of the Applicant's claimed present invention. There are no relevant teachings in Goldin et al., that would ever lead one of ordinary skill in this field to arrive at the Applicant's claimed present invention of Claims 6-8.

Although Goldin et al. teaches use of a position sensor, the reference is directed specifically toward measuring tissue contact only and lacks any teaching or suggestion that its tissue contact method could ever be used to measure temperature at a site within a patient using a temperature measurement signal that is provided to the position sensor by a location system; and measuring the voltage at the position sensor by the system; and determining a resistance value based on the temperature measurement signal and the voltage and a temperature value based on the resistance value (through a temperature sensitivity algorithm in the system that uses a resistance drift factor); and generating an externally applied field at the patient using a generator frequency that is different than the temperature measurement signal, such that the generator signal is an AC magnetic field and wherein the generator signal is 3 KHz and the temperature measurement signal is 4 KHz.

The claimed present invention of Applicant's Claims 6-8 do not use or claim Goldin et al.'s tissue contact system and method. And, Goldin et al. clearly teaches away from the method steps set forth in Claims 6-8 (in combination with Claims 1 –5) in which the Applicant is claiming. Thus at the time of Applicant's invention, the art actually taught away from the Applicants' invention.

Douglass et al. actually teaches temperature detector systems and methods that are directly related to "integrated circuit temperature detection systems and methods". Column 1, Lines 35-37. Additionally, it is noted that Douglas et al. is directed toward industrial applications such as temp-cycle test equipment, air conditioning, monitoring equipment and automatic systems such as process control systems. Column 1, Lines 40-52. Even when

Serial No. 09/882,126

combined with the other prior art references, Douglas et al. does not teach or suggest the combination of novel method steps found with the Applicants claimed present invention of Claims 16 -21.

The claimed present invention of Applicant's Claims 16-21 do not use or claim Douglass et al.'s temperature detector systems and methods for integrated circuits. And, Douglass et al. clearly teaches away from the method steps set forth in 16-21 (in combination with Claims 13-15 respectively) in which the Applicant is claiming. Thus at the time of Applicant's invention, the art actually taught away from the Applicants' invention. Thus, Douglass et al. taught away from the invention as claimed, and therefore, cannot rightly be combined with the other prior art references in a failed attempt to render the present invention obvious.

Accordingly, by this Amendment and for the reasons listed above, Applicant's claimed present invention is neither anticipated by nor rendered obvious by the cited prior art references, and favorable action is respectfully requested.

Accordingly, favorable action is respectfully requested.

Respectfully submitted,

By: /Louis J. Capezzuto/
Louis J. Capezzuto
Reg. No. 37,107

Johnson & Johnson
One Johnson & Johnson Plaza
New Brunswick, NJ 08933-7003
(732) 524-2218
Dated: August 11, 2008